

Remarks

In the March 9, 2006 Office Action (hereinafter “Final Rejection”), the Examiner rejected method claims 34-39 and 43 as directed to non-statutory subject matter under 35 U.S.C. § 101. Applicant respectfully traverses this rejection. There can be no question that game play is proper statutory subject matter. Indeed, the prior art of Henry and Alexander relied upon by the Examiner in support of the Section 103(a) obviousness rejections establishes this very point. With regard to the rejected claims, the claims themselves contain the game playing instructions requiring physical interaction between the players and the game pieces such as the collection of directions, causing a first player to respond to the directions and causing directions to be presented to a second player and evoking the response of the second player. The responses are then communicated from player to player. These are tangible physical acts involving human interaction and the use of cognitive skills to read the instructions or to listen to the instructions being presented. This physical act is followed by another physical act, the formulation and communication of a response to the directions. The communication of a response necessarily requires some type of tangible result such as sound waves produced by an oral response or written word as would be the “communication of a response” by one of the players. In view of the required activities, and the creation of tangible results, either as spoken or written word, it is respectfully submitted that the claim is directed to a proper statutory method claim.

Moreover, the statutory subject matter rejection cuts too wide of a swath. The dependent claims 35-39, involve movement of physical objects or physical manifestations around a game playing surface. There is no dispute that such activities are

proper patentable subject matter under Section 101. The statutory subject matter rejection of claims 34-39 and 43 must be withdrawn.

All of the claims were also rejected on the basis of utility, because it is alleged that the disclosed invention is inoperative. The rejection must be withdrawn because it does not follow the teachings of *In re Brana*, 51 F.3d 1560 (Fed. Cir. 1995). According to *Brana*, it is the initial burden of the PTO to come forward with evidence to challenge the *presumptively* correct assertion of utility. Despite the applicant's express assertion that certain tasks stimulate certain types of different memory systems in the human brain, (see Specification at Paragraphs [0036 – 0041]) the Examiner has not presented any evidence to cast reasonable doubt upon applicant's utility assertion. The Examiner merely argues without evidence that to him, the way in which players will respond to the various cards is subjective to the individual. The example provided about blue sky and pink sky is not evidence; it is only argument without factual basis, and certainly does not represent the perspective of a person having ordinary skill in the art..

In response to the Examiner's earlier rejections on this basis, applicant previously submitted references to peer-reviewed scientific literature that recognize and explain the physiological and psychological rationales why there are different memory systems in the human brain, that they are located in physically distinct regions and that these regions are stimulated differently. This evidence, coupled with the reasonable assertion of utility contained in Paragraphs [0036 - 0041] of the specification, is more than sufficient to preclude any reasonable doubt by those having ordinary skill in the art. As such, the utility rejection must be removed.

Claims 23 and 27 were rejected under 35 U.S.C. § 112, first paragraph, as indefinite. The language objected to by the Examiner must be interpreted in light of the specification. The specification at paragraph [0055] describes short term memory exercises in which fictitious information is presented to the player to require stimulation of the short term memory system of the human brain. In one embodiment, the data presented on the card is random, or has no commonly known association or personally significant relation. Therefore, it is information of the type that would be forgotten very quickly. When viewed in the light of the specification, the claim terms are sufficiently definite, and the Section 112 rejections must be removed.

Applicant has cancelled claim 39 in response to the written description rejection without prejudice to the presentation of this claim in continuing applications.

In the Final Rejection, all of the claims have been rejected under Section 103 in view of Henry combined with Alexander. Even if one assumes that the teachings of these disparate games could be combined, an assumption that applicant traverses, the combination does not teach what is claimed in the currently pending claims. What is claimed herein in either apparatus or method form is game play in which sets of specially designed cards or instructions are intentionally chosen and segregated to correspond to and stimulate recollection from a specific memory system. There is one task per card or instruction. The result is that the player's responses are prompted by the card or instruction to originate from one of the specific memory systems, consistent with the design of the question and/or direction. The prior art relied upon by the Examiner fails to show these limitations. For example, Alexander utilizes activities that address only the semantic memory system. This reference fails to teach the presentation of activities that

address two or more aspects of human memory. In conclusion, the rejection based upon these references under Section 103 must be withdrawn.

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